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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,172	07/25/2001	Oren Globerman	34982	7714

67801 7590 12/17/2007  
MARTIN D. MOYNIHAN d/b/a PRTSI, INC.  
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EXAMINER
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PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3774

MAIL DATE	DELIVERY MODE
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12/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/890,172	GLOBERMAN ET AL.	
	Examiner	Art Unit	
	Paul B. Prebilic	3774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 25,32,59,69,72-74,83,85,93,96,98-103,116-118,220,221 and 226 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 59,69,72,93,98-102 and 220 is/are allowed.
- 6) ☒ Claim(s) 25,32,73,74,83,85,103,116-118,221 and 226 is/are rejected.
- 7) ☒ Claim(s) 96 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The indicated allowability of certain claims has been withdrawn due to a new understanding of one of the prior art references of record. The Examiner regrets the delay in making this discovery.

#### ***Claim Objections***

Claim 96 is objected to because of the following informalities:

On the last line of claim 96, "the extension deformation" lacks clear antecedent basis. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 32, 73, 74, 83, 103, 221, and 226 are rejected under 35 U.S.C. 102(b) as being anticipated by Metz (DE 1,810,799). Metz anticipates the claim language where:

- the axial tube as claimed is met by sleeve b of Metz (see Figures 3 and the paragraph bridging pages 6 and 7 of the translation thereof)
- the slits as claimed are between the extensions shown in the sections of Metz
- the surface as claimed is the inner surface of the sleeve

- the spacer and tube as claimed is met by the nail and sleeve that are inherently capable of supporting a vertebral body of a cadaver or at least because it is able support a fracture in a long bone
- one extension of Metz is inherently capable of carrying greater stress because it has a shorter lever arm than another; see Figures 3. The lower or distal extensions of Metz are shorter and thus inherently capable of carrying greater stress due to there shorter lever arms.

With regard to claim 25, the inner bolt as claimed is screw d and the head thereof has threads that are protrusions extending therefrom.

With regard to claim 32, the horizontal segment as claimed is met by one of the ribs f of Metz.

With regard to claims 73 and 221, the protrusions as claimed are met by the ribs f of Metz.

With regard to claims 83 and 126, the extensions as claims are made of 4 legs running serially along the sleeve axis, the extension top as claimed is the rib between two pairs of legs or on the ends thereof.

With regard to claim 103, a long bone nail designed for a small mammal could be used in the spine of an adult human. For this reason, the functional language of this claim is considered to be fully met.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 85 is rejected under 35 U.S.C. 102(b) as anticipated by Metz (DE 1,810,799) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Metz (DE 1,810,799) alone. Metz teaches making the nail out of steel (see page 8 of the translation) but not annealing the same. However, the Examiner asserts that annealing would not make the device different from that of Metz because, at the minimum, the degree to which the annealing has been performed is not claimed.

Alternatively, one could interpret the claimed annealing method step as requiring a structural difference in the final product. However, the Examiner asserts that any difference implied by the anneal step of unspecified scope would be slight and would not result in a patentably distinct device from that of Metz; see MPEP 2113 that is incorporated herein by reference.

Claims 116-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metz (DE 1,810,799) in view of Buechel et al (US 5,702,448). Metz meets the claim language as explained in the Section 102 rejection supra but Metz fails to teach coating the device as claimed. However, Buechel teaches that it was known to coat the implant with bone ingrowth or retarding material to provide load bearing surfaces that promote or retard ingrowth as needed; see column 4, lines 36-56. Therefore, it is the Examiner's position that it would have been obvious to coat the implant of Metz with a coating to promote or prevent ingrowth for the same reasons that Buechel does the same.

***Allowable Subject Matter***

Claims 59, 69, 72, 93, 98-102, and 220 are allowed over the prior art.

***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774